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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,942	03/05/2002	Geoffrey Fonseca	679.0029USX	6887

7590

09/17/2004

CHARLES N.J. RUGGIERO, ESQ.  
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.  
10TH FLOOR  
ONE LANDMARK SQUARE  
STAMFORD, CT 06901-2682

EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/090,942	FONSECA ET AL.	
	Examiner	Art Unit	
	Eduardo C. Robert	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-24, 26-35, 37-44 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26-35, 37-44 and 47-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2004 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-24, 26-29, 34, 35, 37-40, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (U.S. Patent 6,073,634).

Gueret discloses a method of applying a cosmetic to a surface of a human comprising the steps of depositing a cosmetic composition, e.g. mascara, on one or more bristles of an applicator brush, e.g. 1, and transferring the cosmetic composition to the surface of the human, e.g. eyelashes. The bristles can be made from vegetable fiber (see col. 8, lines 41 and 42) which inherently includes polymeric material. Furthermore, vegetable fiber is biodegradable and it is a renewable plant source, i.e. to obtain fiber from a vegetable is has to be process somehow.

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Gueret discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide with the structure set forth in claims 27 and 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Gueret of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide (as set forth in claim 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claims 28 and 39) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 47 and 50, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to use with the method of Gueret a plant source like corn or wheat or sugar beet, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claim 49, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use with the method Gueret a material such as a medicament, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Claims 22-24, 26-29, 31-35, 37-40, 42-44, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castells Ribas (U.S. Patent 6,314,967).

Castells Ribas discloses a brush for application of mascara on eyelashes. Bristles of the brush are made from vegetable fibers, e.g. cotton. It is noted that cotton is a polymer. Castells Ribas clearly discloses the method used for using mascaras brushes, the mascaras brushes are used by applying a cosmetic material, e.g. mascara, to the bristles of the brush and then applying the cosmetic material with the brush on the eyelashes (see col. 1, lines 22-27). Castells Ribas clearly discloses that this method or procedure is a well known in the art and old. Furthermore, cotton is biodegradable and it is a renewable plant, i.e. in order to obtain cotton is has to be process.

Castells Ribas discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide with the structure set forth in claim 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Castells Ribas of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide (as set forth in claims 27 and 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claims 28 and 39) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 33 and

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44, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to construct the handle of Castells Ribas of a polymeric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claims 47 and 50, it would have been further obvious to one having ordinary skill in the art at the time the invention was made to use with the method of Castells Ribas a plant source like corn or wheat or sugar beet, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claim 49, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use with the method Castells Ribas a material such as a medicament, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 22, 24, 26-28, 30, 34, 37-39, 41, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morganroth (U.S. Patent 4,209,027).

Morganroth discloses a method of treating hair including the steps of depositing a cosmetic material, e.g. hair dye, etc. (see col. 1, lines 20-27) on the bristles of a brush and then applying the material with the brush onto a surface, e.g. hair. The bristles can be made from vegetable fibers. It is noted that vegetable fibers inherently include polymers. Morganroth discloses the claimed invention except for the bristles being made from polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on

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starch or starch derivatives, or a polylactide with the structure set forth in claims 27 and 38. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the bristles of Morganroth of polylactide, or polycaprolactone, or polyhydroxybutyrate/valerate, or polyglycolic acid, or polymer based on starch or starch derivatives, or a polylactide (as set forth in claim 38), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard the average molecular weight of the polylactide (as set forth in claims 28 and 39) being about 50,000 to about 250,000, it noted that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 47 and 50, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use with the method of Morganroth a plant source like corn or wheat or sugar beet, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to claim 49, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use with the method Morganroth a material such as a medicament, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

*Response to Arguments*

Applicant's arguments filed on August 25, 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Applicant's arguments with regard to the claims rejected under 35 U.S.C. 103 do not overcome the rejections applied thereto, since applicant has not provide any convincing showing that these are nothing more than selection of a known material on the basis of its suitability for the intended use or a selection of a workable range as asserted by the examiner. **Applicant has not provided any showing that such limitations are "critical".** In re Cole, 140 USPQ 230 (CCPA 1964); In re Kuhle, 188 USPQ 7 (CCPA 1975); In re Davies, 177 USPQ 381 (CCPA 1973). **Mere arguments by counsel cannot take the place of evidence.** In re Cole, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); In re Walters, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al. Furthermore, applicants have not provided any evidence establishing that the materials are new material for constructing fibers usable for making bristles. A statement or argument by the attorney is not factual evidence.



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*Conclusion*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

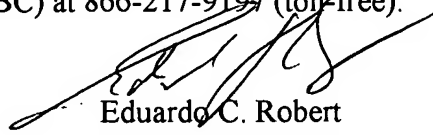
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.